

MAIL STOP PCT
PATENT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Application No.: 10/574,778
PCT Appl. No.: PCT/JP2004/014848
Applicant: Kazuhiro MANSEKI et al.
Filing Date: April 6, 2006
Group Art Unit: Unknown
Title: RARE EARTH COMPLEX EXCELLENT IN THERMAL
RESISTANCE

Docket No.: 9694D-000041/US

**REQUEST FOR RECORDATION OF
INTERNATIONAL PRELIMINARY EXAMINATION REPORT**

MAIL STOP PCT

September 5, 2006

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

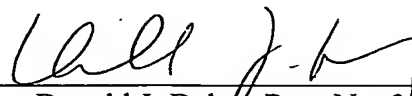
Applicant attaches hereto an International Preliminary Examination Report and an English Translation thereof which has been issued in connection with the above-identified application. Please make this document part of the prosecution history of the present application.

Respectfully submitted,

HARNESS, DICKEY & PIERCE,

P.L.C.

By:



Donald J. Daley, Reg. No. 34, 313

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

DJD:amp

Attachment: International Preliminary Examination Report

PATENT COOPERATION TREATY

PCT/JP2004/014848

**PCT**NOTIFICATION CONCERNING
TRANSMITTAL OF COPY OF INTERNATIONAL
PRELIMINARY REPORT ON PATENTABILITY
(CHAPTER I OF THE PATENT COOPERATION
TREATY)

(PCT Rule 44bis.1(c))

From the INTERNATIONAL BUREAU

To:

KAWAMIYA, Osamu
AOYAMA & PARTNERS, IMP Building, 3-7, Shiromi
1-chome, Chuo-ku, Osaka-shi, Osaka
5400001
JAPONDate of mailing (day/month/year)
20 April 2006 (20.04.2006)Applicant's or agent's file reference
664597**IMPORTANT NOTICE**International application No.
PCT/JP2004/014848International filing date (day/month/year)
07 October 2004 (07.10.2004)Priority date (day/month/year)
07 October 2003 (07.10.2003)

Applicant

JURIDICAL FOUNDATION OSAKA INDUSTRIAL PROMOTION ORGANIZATION et al

The International Bureau transmits herewith a copy of the international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)

The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland

Authorized officer

Yoshiko Kuwahara

Facsimile No.+41 22 740 14 35

Facsimile No.+41 22 338 90 90

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference 664597	FOR FURTHER ACTION	See item 4 below
International application No. PCT/JP2004/014848	International filing date (<i>day/month/year</i>) 07 October 2004 (07.10.2004)	Priority date (<i>day/month/year</i>) 07 October 2003 (07.10.2003)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant JURIDICAL FOUNDATION OSAKA INDUSTRIAL PROMOTION ORGANIZATION		

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).

2. This REPORT consists of a total of 5 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the report |
| <input type="checkbox"/> | Box No. II | Priority |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input checked="" type="checkbox"/> | Box No. VIII | Certain observations on the international application |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Date of issuance of this report 10 April 2006 (10.04.2006)
Facsimile No. +41 22 740 14 35	Authorized officer <div style="text-align: center; font-weight: bold;">Yoshiko Kuwahara</div>
Telephone No. +41 22 338 90 90	

REC'D 31 MAR 2005

特許協力条約

発信人 日本国特許庁 (国際調査機関)

WIPO

PCT

出願人代理人

河宮 治

様

あて名

〒 540-0001

大阪府大阪市中央区城見1丁目3番7号
IMPビル 青山特許事務所PCT
国際調査機関の見解書
(法施行規則第40条の2)
[PCT規則43の2.1]発送日
(日.月.年)

29.3.2005

出願人又は代理人
の書類記号

664597

今後の手続きについては、下記2を参照すること。

国際出願番号

PCT/J P 2004/014848

国際出願日

(日.月.年)

07.10.2004

優先日

(日.月.年)

07.10.2003

国際特許分類 (IPC)

Int. Cl.⁷

C07C49/92, 69/88, C08K5/00, C08L101/00 // C07F5/00, C09K11/06

出願人 (氏名又は名称)

財団法人大阪産業振興機構

1. この見解書は次の内容を含む。

- ☒ 第I欄 見解の基礎
☐ 第II欄 優先権
☐ 第III欄 新規性、進歩性又は産業上の利用可能性についての見解の不作成
☐ 第IV欄 発明の単一性の欠如
☒ 第V欄 PCT規則43の2.1(a)(i)に規定する新規性、進歩性又は産業上の利用可能性についての見解、それを裏付けるための文献及び説明
☐ 第VI欄 ある種の引用文献
☐ 第VII欄 国際出願の不備
☒ 第VIII欄 国際出願に対する意見

2. 今後の手続き

国際予備審査の請求がされた場合は、出願人がこの国際調査機関とは異なる国際予備審査機関を選択し、かつ、その国際予備審査機関がPCT規則66.1の2(b)の規定に基づいて国際調査機関の見解書を国際予備審査機関の見解書とみなさない旨を国際事務局に通知していた場合を除いて、この見解書は国際予備審査機関の最初の見解書とみなされる。

この見解書が上記のように国際予備審査機関の見解書とみなされる場合、様式PCT/ISA/220を送付した日から3月又は優先日から22月のうちいずれか遅く満了する期限が経過するまでに、出願人は国際予備審査機関に、適当な場合は補正書とともに、答弁書を提出することができる。

さらなる選択肢は、様式PCT/ISA/220を参照すること。

3. さらなる詳細は、様式PCT/ISA/220の備考を参照すること。

見解書を作成した日

17.03.2005

名称及びあて先

日本国特許庁 (ISA/J P)

郵便番号100-8915

東京都千代田区鍛冶が関三丁目4番3号

特許庁審査官 (権限のある職員)
本堂裕司

4H

9049

電話番号 03-3581-1101 内線 3443

様式PCT/ISA/237 (表紙) (2004年1月)

第 I 欄 見解の基礎

1. この見解書は、下記に示す場合を除くほか、国際出願の言語を基礎として作成された。

- ☐ この見解書は、_____ 語による翻訳文を基礎として作成した。
それは国際調査のために提出された PCT 規則 12.3 及び 23.1(b) にいう翻訳文の言語である。

2. この国際出願で開示されかつ請求の範囲に係る発明に不可欠なヌクレオチド又はアミノ酸配列に関して、以下に基づき見解書を作成した。

- a. タイプ ☐ 配列表
☐ 配列表に関連するテーブル

- b. フォーマット ☐ 書面
☐ コンピュータ読み取り可能な形式

- c. 提出時期 ☐ 出願時の国際出願に含まれる
☐ この国際出願と共にコンピュータ読み取り可能な形式により提出された
☐ 出願後に、調査のために、この国際調査機関に提出された

3. ☐ さらに、配列表又は配列表に関連するテーブルを提出した場合に、出願後に提出した配列若しくは追加して提出した配列が出願時に提出した配列と同一である旨、又は、出願時の開示を超える事項を含まない旨の陳述書の提出があった。

4. 補足意見：

第V欄 新規性、進歩性又は産業上の利用可能性についてのPCT規則43の2.1(a)(i)に定める見解、
それを裏付ける文献及び説明

1. 見解

新規性 (N)	請求の範囲	2, 4~8, 10~12	有 無
	請求の範囲	1, 3, 9, 13~14	
進歩性 (IS)	請求の範囲	2, 4~8, 10~12	有 無
	請求の範囲	1, 3, 9, 13~14	
産業上の利用可能性 (IA)	請求の範囲	1~14	有 無
	請求の範囲		

2. 文献及び説明

文献1 : GAJADHAR-PLUMMER, Alison S. et al.,
One-Pot Synthesis, Structure, and Unusual Luminescence of Novel
One-Dimensional Lanthanide(III) Tetramethoxyborates,
Inorganic Chemistry, 1999, Vol.38 No.8, p.1745-1753

文献2 : BRZYSKA, W. et al.,
Thermal decomposition of rare earth element 2,4-dihydroxybenzoates
in air,
Thermochimica Acta, 1992, No.211, p.199-207

請求の範囲1, 3, 9, 13~14は、国際調査報告で引用された文献1のTable 1,2に記載されているので、新規性及び進歩性を有さない。

請求の範囲1, 3, 9は、国際調査報告で引用された文献2のTABLE 1,2,3に記載されているので、新規性及び進歩性を有さない。

請求の範囲2, 4~8, 10~12に記載された発明は、国際調査報告で引用された文献又は当該発明に関連があると認められるいずれの文献にも記載されておらず、かつ、当業者にとって自明なものでもない。

第Ⅳ欄 国際出願に対する意見

請求の範囲、明細書及び図面の明瞭性又は請求の範囲の明細書による十分な裏付についての意見を次に示す。

請求の範囲 1 ～ 2, 9, 13 ～ 14 は、「光増感機能を有する」及び／又は「振動エネルギー失活抑制機能を有する」錯体に関するものであるが、PCT 6 条の意味において明細書に裏付けられ、また、PCT 5 条の意味において開示されているのは、クレームされた化合物の一部に過ぎないものと認められる。

よって、請求の範囲 1 ～ 2, 9, 13 ～ 14 の国際調査は、明細書に具体的に開示された請求項 3 及び [0024] [0025] の例示に記載された化合物に関する範囲で行った。



PATENT COOPERATION TREATY

PCT/JP2004/014848

PCT

NOTIFICATION OF TRANSMITTAL
OF COPIES OF TRANSLATION
OF THE INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY
(CHAPTER I OR CHAPTER II
OF THE PATENT COOPERATION TREATY)
(PCT Rules 44bis.3(c) and 72.2)

From the INTERNATIONAL BUREAU

To:

KAWAMIYA, Osamu
AOYAMA & PARTNERS, IMP Building, 3-7, Shiromi
1-chome, Chuo-ku, Osaka-shi, Osaka
5400001
JAPON

Date of mailing (day/month/year) 29 June 2006 (29.06.2006)	
Applicant's or agent's file reference 664597	IMPORTANT NOTIFICATION
International application No. PCT/JP2004/014848	International filing date (day/month/year) 07 October 2004 (07.10.2004)
Applicant JURIDICAL FOUNDATION OSAKA INDUSTRIAL PROMOTION ORGANIZATION et al	

1. Transmittal of the translation to the applicant.



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter I).



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter II).

2. Transmittal of the copy of the translation to the designated or elected Offices.

The International Bureau notifies the applicant that copies of that translation have been transmitted to the following designated or elected Offices requiring such translation:

None

The following designated or elected Offices, having waived the requirement for such a transmittal at this time, will receive copies of that translation from the International Bureau only upon their request:

AE, AG, AL, AM, AP, AT, AU, AZ, BA, BB, BG, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EA, EC, EE, EG, EP, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NA, NI, NO, NZ, OA, OM, PG, PH, PL, PT, RO, RU, SC, SD, SE, SG, SK, SL, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, YU, ZA, ZM, ZW

3. Reminder regarding translation into (one of) the official language(s) of the elected Office(s).

The applicant is reminded that, where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability (Chapter II).

It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned within the applicable time limit (Rule 74.1). See Volume II of the PCT Applicant's Guide for further details.

The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland

Authorized officer

Yoshiko Kuwahara

Facsimile No.+41 22 740 14 35

Facsimile No.+41 22 338 90 90

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference 664597	FOR FURTHER ACTION	See item 4 below
International application No. PCT/JP2004/014848	International filing date (<i>day/month/year</i>) 07 October 2004 (07.10.2004)	Priority date (<i>day/month/year</i>) 07 October 2003 (07.10.2003)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant JURIDICAL FOUNDATION OSAKA INDUSTRIAL PROMOTION ORGANIZATION		

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).
2. This REPORT consists of a total of 5 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the report |
| <input type="checkbox"/> | Box No. II | Priority |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input checked="" type="checkbox"/> | Box No. VIII | Certain observations on the international application |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Date of issuance of this report 20 June 2006 (20.06.2006)
Facsimile No. +41 22 740 14 35	Authorized officer Yoshiko Kuwahara
Telephone No. +41 22 338 90 90	

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

TRANSLATION

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:

Date of mailing
(day/month/year)

Applicant's or agent's file reference

664597

FOR FURTHER ACTION

See paragraph 2 below

International application No.

PCT/JP2004/014848

International filing date (day/month/year)

07.10.2004

Priority date (day/month/year)

07.10.2003

International Patent Classification (IPC) or both national classification and IPC

Applicant

JURIDICAL FOUNDATION OSAKA INDUSTRIAL PROMOTION ORGANIZATION

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability: citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/JP

Authorized officer

Facsimile No.

Telephone No.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/JP2004/014848

Box No. 1

Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
☐ This opinion has been established on the basis of a translation from the original language into the following language
_____, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material
☐ a sequence listing
☐ table(s) related to the sequence listing
 - b. format of material
☐ in written format
☐ in computer readable form
 - c. time of filing/furnishing
☐ contained in the international application as filed.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/JP2004/014848

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability:
citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	2, 4-8, 10-12	YES
	Claims	1, 3, 9, 13-14	NO
Inventive step (IS)	Claims	2, 4-8, 10-12	YES
	Claims	1, 3, 9, 13-14	NO
Industrial applicability (IA)	Claims	1-14	YES
	Claims		NO

2. Citations and explanations:

Document 1: GAJADHAR-PLUMMBER, Alison S. et al., "One-Pot Synthesis, Structure, and Unusual Luminescence of Novel One-Dimensional Lanthanide (III) Tetramethoxyborates," Inorganic Chemistry, 1999, Vol. 38 No. 8, pp. 1745-1753

Document 2: BRZYSKA, W. et al., "Thermal Decomposition of Rare Earth Element 2, 4-Dihydroxybenzoates in Air," Thermochimica Acta, 1992, No. 211, pp. 199-207

Since claims 1, 3, 9, 13-14 are described in Tables 1 and 2 of document 1 cited in the ISR, they appear to be neither novel nor involve an inventive step.

Since the subject matters of claims 1, 3 and 9 are described in Tables 1, 2, 3 of document 2 cited in the ISR, they appear to be neither novel nor involve an inventive step.

The subject matters of claims 2, 4-8 and 10-12 are not described in either of the documents cited in the ISR nor in any of the documents recognized as related to the inventions concerned. As such, they are non-obvious to a person skilled in the art.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/JP2004/014848

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

Claims 1-2, 9 and 13-14 relate to a complex that "has a photosensitizing function" and/or "equipped with a vibration energy deactivating function," but are corroborated in the description within the meaning of PCT Article 6, and what is disclosed within the meaning of PCT Article 5 is considered nothing more than one part of the compound claimed in the present application.

Therefore, the international search regarding claims 1-2, 9, 13-14 was carried out within the scope of the compound described in claim 3, which is specifically disclosed in the description and in the illustrative example found in paragraphs [0024] and [0025].